



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: NELSON ET AL. Examiner: K. ROWAN  
Serial No.: 10/033,634 Group Art Unit: 3643  
Filed: DECEMBER 27, 2001 Docket: 163.1118USD1  
Confirmation No.: 9710  
Title: FLY TRAP WITH MULTIPLE LIGHT PATTERNS

CERTIFICATE UNDER 37 CFR 1.8:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on July 25, 2005.

By: Kristine A. Wacek  
Name: Kristine A. Wacek

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

23552

PATENT TRADEMARK OFFICE

Sir:

We are transmitting herewith the attached:

- ☒ Transmittal Sheet in duplicate containing Certificate of Mailing
- ☒ Check(s) in the amount of \$180.00 for filing Supplemental IDS after receipt of Office Action
- ☒ Supplemental Information Disclosure Statement, Form 1449, 1 Reference(s)
- ☒ Other: Further Notification of Litigation, copies of Amended Complaint, Defendants' Answer and Counterclaims to Plaintiff's Amended Complaint, and Order of Dismissal
- ☒ Return postcard

Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers or any future reply, if appropriate. Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725. A duplicate of this sheet is enclosed.

Merchant & Gould P.C.  
P.O. Box 2903  
Minneapolis, MN 55402-0903  
612.332.5300

By: Kate DeVries Smith  
Name: Katherine M. DeVries Smith  
Reg. No.: 42,157  
KDeVriesSmith:PLSkaw

S/N 10/033,634

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: NELSON ET AL. Examiner: K. ROWAN  
Serial No.: 10/033,634 Group Art Unit: 3643  
Filed: DECEMBER 27, 2001 Docket No.: 163.1118USD1  
Title: FLY TRAP WITH MULTIPLE LIGHT PATTERNS

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on July 25, 2005.

By: Kristine A. Wacek  
Name: Kristine A. Wacek

FURTHER NOTIFICATION OF LITIGATION

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450



Dear Sir:

Applicant hereby provides the US Patent & Trademark Office with copies of additional documents from a litigation proceeding involving the following patents owned by Ecolab Inc. ("Ecolab"), which have the following relationship to the present above-captioned patent application:

1. U.S. Patent No. 5,365,690 ("the '690 patent"), to which the present application claims priority.
2. U.S. Patent No. 5,505,017 ("the '017 patent"), to which the present application also claims priority and which claims priority to the '690 patent, and
3. U.S. Patent No. 6,493,986 ("the '986 patent"), which also claims priority to the '690 patent

PestWest Suit

The PestWest lawsuit (Civil Action No. 04-CV-3049 in the District of Minnesota) was previously described in the Notification of Litigation filed in February 2005. This case has now been dismissed. The following pleading documents related to this lawsuit are attached:

1. Amended Complaint, filed January 25, 2005;
2. Defendants' Answer and Counterclaims to Plaintiff's Amended Complaint, filed February 14, 2005; and
3. Order for Dismissal of July 11, 2005.

The Examiner is encouraged to contact Ecolab's undersigned representative with any questions or if the Examiner would like to review additional documents or pleadings related to any of the proceedings described above.

Respectfully submitted,

MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, Minnesota 55402-0903  
(612) 332-5300

Date: July 25, 2005

Kate DeVries Smith  
Katherine M. DeVries Smith  
Reg. No. 42,157  
KDS:PLSkaw

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF MINNESOTA

ECOLAB INC.,	)	
	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civil No. 04-3049 JMR/FLN
	)	
PESTWEST ELECTRONICS LTD. and	)	
PESTWEST USA, LLC,	)	
	)	
Defendants.	)	
	)	

**AMENDED COMPLAINT**

Comes now the Plaintiff, and for its Amended Complaint against Defendants, states and alleges as follows:

**THE PARTIES**

1. Plaintiff, Ecolab Inc., is incorporated in the State of Delaware, having a principal place of business at Ecolab Center, 370 North Wabasha Street, St. Paul, Minnesota 55102.

2. Upon information and belief, Defendant, PestWest Electronics Ltd., is a foreign limited liability company, having a principal place of business at Denholme Drive, Ossett, West Yorkshire, WF5 9NB, UK.

3. Upon information and belief, Defendant, PestWest USA, LLC, is incorporated in the State of South Carolina, having its registered office at 104 South Main Street, Suite 900, Greenville, South Carolina 29601, and its principal place of business at 6934 Riversedge Street Circle, Bradenton, Florida 34202-4018.

4. Plaintiff is engaged in the business of manufacturing, distributing, and selling a wide variety of cleaning and sanitizing products and services including pest elimination products and services to a wide variety of customers including hotels, restaurants, health care facilities, food and beverage processing plants, and others.

5. Plaintiff Ecolab has been a leader in the institutional commercial pest elimination business and a leader in program and technological product innovations, such as its Ecolab Flying Insect Defense Program and its Stealth<sup>®</sup> Fly System.

6. Defendants PestWest Electronics Ltd. and Pest West USA, LLC, are engaged, inter alia, in the business of importing into and selling in the United States pest elimination products including flying insect control equipment for similar applications.

### **JURISDICTION**

7. This is a claim of patent infringement arising under the Acts of Congress relating to patents, 35 U.S.C. §§ 271 and 282-85.

8. This Court has jurisdiction under 28 U.S.C. §§ 1331 and 1338(a).

9. Venue is proper in this Court pursuant to 28 U.S.C. §§ 1391 and 1400.

### **COUNT I - PATENT INFRINGEMENT**

10. On November 22, 1994, United States Patent No. 5,365,690 (hereinafter "the '690 patent") entitled ADHESIVE LIGHT TRAP was duly and legally issued to Plaintiff; and since that date Plaintiff has been, and still is, the owner of the '690 patent. A copy of the '690 patent is attached hereto as Exhibit A.

11. On March 3, 1998, Reexamination Certificate B1 5,365,690 was duly and legally issued, confirming the patentability of claims 1-5, 7-10, 13-19, and 21-24. New claims 25-26 were added to the '690 patent. A copy of Reexamination Certificate B1 5,365,690 is attached hereto as Exhibit B.

12. On October 16, 1998, the United States District Court for the District of Minnesota entered a final judgment by consent decree in *Ecolab Inc. v. Gilbert Industries, Inc.*, Civil Action No. 3-94-1505, that the '690 patent is a valid pioneering patent. A copy of the final judgment in that case is attached hereto as Exhibit C.

13. On December 5, 2002, a jury empanelled in the United States District Court for the District of Minnesota rendered a verdict in *Ecolab Inc. v. Gardner Manufacturing Company*,

*Inc.*, Civil Action No. 98-2294, upholding the validity of the '690 patent. Copies of the special verdict forms and final judgment rendered in that case are attached hereto as Exhibit D.

14. On April 9, 1996, United States Patent No. 5,505,017 (hereinafter "the '017 patent") entitled FLYING INSECT TRAP USING REFLECTED AND RADIATED LIGHT was duly and legally issued to Plaintiff; and since that date Plaintiff has been, and still is, the owner of the '017 patent. A copy of the '017 patent is attached hereto as Exhibit E.

15. On December 17, 2002, United States Patent No. 6,493,986 B1 (hereinafter "the '986 patent") entitled LIGHT TRAP FOR INSECTS was duly and legally issued to Plaintiff; and since that date Plaintiff has been, and still is, the owner of the '986 patent. A copy of the '986 patent is attached hereto as Exhibit F.

16. Defendants PestWest Electronics Ltd. and Pest West USA, LLC, have infringed the '690, '017, and '986 patents through the manufacture, importation, use, sale and/or offer for sale of flying insect traps including, but not limited to, the Mantis Uplight decorative insect light trap. A copy of the PestWest USA web page depicting and describing the Mantis Uplight is attached hereto as Exhibit G.

17. Plaintiff has been damaged by Defendants' infringement of said patents and will continue to be damaged in the future unless Defendants are permanently enjoined from infringing said patents, inducing infringements of said patents, and contributing to the infringement of said patents by others.

18. Upon information and belief, Defendants are aware that the '690, '017, and '986 patents were duly and legally issued and that Defendants' use, manufacture, importation, and sale of the above-identified flying insect traps infringes said patents.

19. Upon information and belief, the Defendants' infringement of said patents is now and has been intentional, willful, and deliberate, and will continue unless enjoined by the Court.

**PRAYER FOR RELIEF**

WHEREFORE, Plaintiff prays for judgment that:

A. United States Patent Nos. 5,365,690, 5,505,017, and 6,493,986 B1 are valid and have been infringed by Defendants.

B. Defendants, their officers, agents, servants and employees and those persons in active concert or participation with any of them be enjoined from further infringement of United States Patent Nos. 5,365,690, 5,505,017, and 6,493,986 B1.

C. An accounting be had for the profits and damages arising out of Defendants' infringement of United States Patent Nos. 5,365,690, 5,505,017, and 6,493,986 B1, including treble damages for willful infringement as provided by Title 35 U.S.C. § 284, with interest;

D. Defendants be preliminarily and permanently enjoined from continued use, importation, or sale of Defendants' product used to infringe said patents;

E. Plaintiff be awarded its attorneys' fees, costs, and expenses in this action; and

F. Plaintiff be awarded such relief as this Court may deem necessary and proper.

**DEMAND FOR JURY TRIAL**

Plaintiff hereby demands a trial by jury of all issues so triable.

Respectfully submitted,

ECOLAB INC.

by its attorneys,

Dated: January 25, 2005

s/Douglas J. Williams

Douglas J. Williams, Reg. No. 117,353  
Rebecca A. Bortolotti, Reg. No. 309,631  
Rachel K. Zimmerman, Reg. No. 314,171  
Rachel Clark Hughey, Reg. No. 328,042  
MERCHANT & GOULD P.C.  
3200 IDS Center  
80 South Eighth Street  
Minneapolis, Minnesota 55402-2215  
Telephone: 612.332.5300

OF COUNSEL:

Andrew Sorensen, Esq.

ECOLAB INC.

Ecolab Center

370 North Wabasha Street

St. Paul, Minnesota 55102

Telephone: 612.293.2432



**UNITED STATES DISTRICT COURT  
DISTRICT OF MINNESOTA**

---

ECOLAB, INC.,  
a Delaware corporation,

Court File No. 04-3049 JMR/FLN

Plaintiff,

vs.

**DEFENDANTS' ANSWER  
AND COUNTERCLAIMS TO  
PLAINTIFF'S AMENDED  
COMPLAINT**

PESTWEST ELECTRONICS, LTD.,  
and PESTWEST USA, LLC,

Defendants.

---

Defendants PestWest Electronics, LTD. and PestWest USA, LLC (collectively "Defendants"), by and through their counsel, hereby jointly answer Plaintiff Ecolab, Inc.'s ("Plaintiff") Amended Complaint as follows:

**ANSWER TO AMENDED COMPLAINT**

1. Defendants are without sufficient knowledge or information to admit the truth of the allegations contained in Paragraph 1 of Plaintiff's Amended Complaint, and therefore deny the same.

2. Defendants admit the information contained in Paragraph 2 of Plaintiff's Amended Complaint.

3. Defendants state only that PestWest USA, LLC is incorporated in the state of South Carolina, with the registered agent being listed at the address provided by Plaintiff. Defendants deny the remaining allegations contained in Paragraph 3 of Plaintiff's Amended Complaint.

4. Defendants are without sufficient knowledge or information to admit the truth of the allegations contained in Paragraph 4 of Plaintiff's Amended Complaint, and therefore deny the same.

5. Defendants are without sufficient knowledge or information to admit the truth of the allegations contained in Paragraph 5 of Plaintiff's Amended Complaint, and therefore deny the same.

6. Defendants state that the Mantis Uplight fly traps are imported into and sold in the United States. Defendants are without sufficient knowledge and information to form a belief as to the meaning of the phrase "are engaged, inter alia, in the business of importing into and selling in the United States pest elimination products including flying insect control equipment for similar application" as contained in Paragraph 6 of Plaintiff's Amended Complaint, and therefore deny all allegations regarding that phrase.

7. Defendants admit that Plaintiff has alleged patent infringement under 35 U.S.C. §§ 271 and 282-85. Defendants deny the merits of the patent infringement allegations contained in Paragraph 7 of Plaintiff's Amended Complaint.

8. Defendants do not dispute that subject matter jurisdiction is proper with this Court, as alleged in Paragraph 8 of Plaintiff's Amended Complaint.

9. Defendants do not dispute that personal jurisdiction and venue are proper with this Court, as alleged in Paragraph 9 of Plaintiff's Amended Complaint.

10. Defendants state only that the face of U.S. Patent No. 5,365,690 ("the '690 Patent") speaks for itself. Defendants deny that the '690 Patent was duly and legally issued. Defendants are without sufficient knowledge or information to admit the truth of the remaining

allegations contained in Paragraph 10 of Plaintiff's Amended Complaint, and therefore deny the same.

11. Defendants state only that the face of the 1998 Reexamination Certificate for the '690 Patent speaks for itself and, therefore, Defendants deny the allegations contained in Paragraph 11 of Plaintiff's Amended Complaint.

12. Defendants state only that the final judgment in the *Ecolab, Inc. v. Gilbert Industries, Inc.* Civil Action speaks for itself and, therefore, Defendants deny the allegations contained in Paragraph 12 of Plaintiff's Amended Complaint.

13. Defendants state only that the jury verdict in the *Ecolab, Inc. v. Gardner Mfg. Co.* Civil Action speaks for itself and, therefore, Defendants deny the allegations contained in Paragraph 13 of Plaintiff's Amended Complaint.

14. Defendants state only that the face of U.S. Patent No. 5,505,017 ("the '017 Patent") speaks for itself. Defendants deny that the '017 Patent was duly and legally issued. Defendants are without sufficient knowledge or information to admit the truth of the remaining allegations contained in Paragraph 14 of Plaintiff's Amended Complaint, and therefore deny the same.

15. Defendants state only that the face of U.S. Patent No. 6,493,986 B1 ("the '986 Patent") speaks for itself. Defendants deny that the '986 Patent was duly and legally issued. Defendants are without sufficient knowledge or information to admit the truth of the remaining allegations contained in Paragraph 15 of Plaintiff's Amended Complaint, and therefore deny the same.

16. Defendants deny the allegations contained in Paragraph 16 of Plaintiff's Amended Complaint.

17. Defendants deny the allegations contained in Paragraph 17 of Plaintiff's Amended Complaint.

18. Defendants deny the allegations contained in Paragraph 18 of Plaintiff's Amended Complaint.

19. Defendants deny the allegations contained in Paragraph 19 of Plaintiff's Amended Complaint.

### **DEFENSES AND AFFIRMATIVE DEFENSES**

Defendants assert the following defenses and affirmative defenses:

20. Plaintiff fails to state a claim against Defendants upon which relief can be granted.

21. Defendants have neither directly infringed, willfully infringed, induced infringement, nor contributorily infringed any valid claim of the '690 Patent, the '017 Patent, or the '986 Patent.

22. The '690 Patent, the '017 Patent, and the '986 Patent are invalid for failure to meet the conditions of patentability specified in 35 U.S.C. §§ 101, 102, and/or 103, and/or failure to comply with the requirements of 35 U.S.C. §§ 112 and 116, and other applicable statutory sections.

23. The '690 Patent, the '017 Patent, and the '986 Patent are unenforceable for failure to meet the duties and obligations specified in 37 C.F.R. § 1.56, and other applicable statutes and/or regulations, for at least the reasons particularly described and pled in Paragraphs 12 through 36 of Defendants' Counterclaims.

24. Plaintiff's claims against Defendants are barred in whole or in part by the doctrine of patent misuse.

25. Plaintiff's claims against Defendants are barred in whole or in part by Plaintiff's failure to mitigate its damages.

26. Plaintiff's claims against Defendants are barred in whole or in part by Plaintiff's unclean hands.

27. Plaintiff's claims against Defendants are barred in whole or in part because Defendants were and are practicing the prior art.

28. Plaintiff's claims against Defendants are barred in whole or in part by the doctrine of laches, including but not limited to prosecution laches.

29. Plaintiff's claims against Defendants are barred in whole or in part by the doctrine of estoppel.

30. Plaintiff's claims against Defendants are barred in whole or in part by the doctrine of acquiescence.

31. Plaintiff's claims against Defendants are barred in whole or in part by the doctrines of license, waiver, and/or intervening rights.

**COUNTERCLAIMS**  
**DECLARATORY JUDGMENT OF NONINFRINGEMENT, INVALIDITY**  
**AND UNENFORCEABILITY OF THE '690 PATENT,**  
**THE '017 PATENT AND THE '986 PATENT**

For its counterclaims against Plaintiff, Defendants hereby state and allege as follows:

1. Defendants incorporate by reference all of the foregoing allegations and averments of their Answer to Plaintiff's Amended Complaint, and Defendants' Defenses and Affirmative Defenses.

2. These counterclaims are for declaratory judgment of noninfringement, invalidity and unenforceability of the '690 Patent, the '017 Patent and the '986 Patent (collectively "Plaintiff's Patents"). This Court has jurisdiction over these counterclaims under the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202, in that Plaintiff has accused Defendants of infringing Plaintiff's Patents. Defendants deny Plaintiff's infringement accusations, thereby creating an actual controversy between the parties. This Court has subject matter jurisdiction over Defendants' counterclaims pursuant to 28 U.S.C. §§ 1338(a) and 1367, and Fed.R.Civ.P. 13.

**COUNTERCLAIM I**  
**NONINFRINGEMENT OF THE '690 PATENT**

3. The accused products made, used, offered for sale, imported, and/or sold by Defendants do not directly infringe, willfully infringe, induce infringement, nor contributorily infringe any valid claim of the '690 Patent.

4. Defendants have not directly infringed, willfully infringed, induced infringement, nor contributorily infringed any valid claim of the '690 Patent.

**COUNTERCLAIM II**  
**INVALIDITY OF THE '690 PATENT**

5. The '690 Patent is invalid for failure to meet the conditions of patentability specified in 35 U.S.C. §§ 101, 102, and/or 103, and/or failure to comply with the requirements of 35 U.S.C. §§ 112 and 116, and other applicable statutory sections.

**COUNTERCLAIM III**  
**NONINFRINGEMENT OF THE '017 PATENT**

6. The accused products made, used, offered for sale, imported, and/or sold by Defendants do not directly infringe, willfully infringe, induce infringement, nor contributorily infringe any valid claim of the '017 Patent.

7. Defendants have not directly infringed, willfully infringed, induced infringement, nor contributorily infringed any valid claim of the '017 Patent.

**COUNTERCLAIM IV**  
**INVALIDITY OF THE '017 PATENT**

8. The '017 Patent is invalid for failure to meet the conditions of patentability specified in 35 U.S.C. §§ 101, 102, and/or 103, and/or failure to comply with the requirements of 35 U.S.C. §§ 112 and 116, and other applicable statutory sections.

**COUNTERCLAIM V**  
**NONINFRINGEMENT OF THE '986 PATENT**

9. The accused products made, used, offered for sale, imported, and/or sold by Defendants do not directly infringe, willfully infringe, induce infringement, nor contributorily infringe any valid claim of the '986 Patent.

10. Defendants have not directly infringed, willfully infringed, induced infringement, nor contributorily infringed any valid claim of the '986 Patent.

**COUNTERCLAIM VI**  
**INVALIDITY OF THE '986 PATENT**

11. The '986 Patent is invalid for failure to meet the conditions of patentability specified in 35 U.S.C. §§ 101, 102, and/or 103, and/or failure to comply with the requirements of 35 U.S.C. §§ 112 and 116, and other applicable statutory sections.

**COUNTERCLAIM VII**  
**INEQUITABLE CONDUCT - UNENFORCEABILITY OF THE '690 PATENT**

12. The '690 Patent is unenforceable against Defendants due to Plaintiff's inequitable conduct during prosecution of that patent.

13. Plaintiff and each individual associated with the filing and prosecution of the patent application that matured into the '690 Patent had a duty to disclose to the United States Patent and Trademark Office all information known to be material to patentability in accordance with 37 C.F.R. § 1.56.

14. On information and belief, Plaintiff knowingly withheld material information from the United States Patent & Trademark Office during the prosecution of the '690 Patent, in violation of 37 C.F.R. § 1.56. Specifically, Plaintiff and/or Plaintiff's counsel was aware of the material, non-cumulative teachings and information contained in German Patent No. 3,840,440 as Plaintiff's counsel, Merchant & Gould, P.C., did and/or does represent the patentee for the German Patent in various patent matters. Plaintiff and/or Plaintiff's counsel failed to disclose the aforementioned German Patent to the United States Patent and Trademark Office during prosecution of the '690 Patent.



**COUNTERCLAIM VIII**  
**INEQUITABLE CONDUCT - UNENFORCEABILITY OF THE '017 PATENT**

15. The '017 Patent is unenforceable against Defendants due to Plaintiff's inequitable conduct during prosecution of that patent.

16. Plaintiff and each individual associated with the filing and prosecution of the patent application that matured into the '017 Patent had a duty to disclose to the United States Patent and Trademark Office all information known to be material to patentability in accordance with 37 C.F.R. § 1.56.

17. On information and belief, Plaintiff knowingly withheld material information from the United States Patent & Trademark Office during the prosecution of the '017 Patent, in violation of 37 C.F.R. § 1.56. Specifically, Plaintiff and/or Plaintiff's counsel was aware of the material, non-cumulative teachings and information contained in German Patent No. 3,840,440 as Plaintiff's counsel, Merchant & Gould, P.C., did and/or does represent the patentee for the German Patent in various patent matters. Plaintiff and/or Plaintiff's counsel failed to disclose the aforementioned German Patent to the United States Patent and Trademark Office during prosecution of the '017 Patent.

**COUNTERCLAIM IX**  
**INEQUITABLE CONDUCT - UNENFORCEABILITY OF THE '017 PATENT**

18. The '017 Patent is unenforceable against Defendants due to Plaintiff's inequitable conduct during prosecution of that patent.

19. Plaintiff and each individual associated with the filing and prosecution of the patent application that matured into the '017 Patent had a duty to disclose to the United States

Patent and Trademark Office all information known to be material to patentability in accordance with 37 C.F.R. § 1.56.

20. Plaintiff and each individual associated with the filing and prosecution of the patent application that matured into the '017 Patent had a duty to disclose the existence of prior or pending litigation involving the subject matter of the '017 Patent in accordance with 37 C.F.R. § 1.56 and the Manual of Patent Examining Procedure ("M.P.E.P.") § 2001.06(c).

21. In the case of *Ecolab, Inc. v. Gilbert Industries, Inc.*, Civil Action No. 3-94-1505 in the United States District Court for the District of Minnesota, Plaintiff claimed, at least in part, that Gilbert Industries, Inc. infringed the '690 Patent.

22. In the case of *Ecolab, Inc. v. Paraclipse, Inc.*, Civil Action No. 94-601 in the United States District Court for the District of Nebraska, Plaintiff claimed, at least in part, that Paraclipse, Inc. infringed the '690 Patent.

23. The '017 Patent is a Continuation of the '690 Patent.

24. On information and belief, Plaintiff knowingly withheld material information from the United States Patent & Trademark Office during the prosecution of the '017 Patent, in violation of 37 C.F.R. § 1.56 and M.P.E.P. § 2001.06(c). Specifically, Plaintiff and/or Plaintiff's counsel was aware of the litigation referenced above in Paragraphs 21 through 22 and failed to disclose the existence of such litigation, and/or any other material information arising therefrom, to the United States Patent and Trademark Office during prosecution of the '017 Patent.

**COUNTERCLAIM X**  
**INEQUITABLE CONDUCT - UNENFORCEABILITY OF THE '986 PATENT**

25. The '986 Patent is unenforceable against Defendants due to Plaintiff's inequitable conduct during prosecution of that patent.

26. Plaintiff and each individual associated with the filing and prosecution of the patent application that matured into the '986 Patent had a duty to disclose to the United States Patent and Trademark Office all information known to be material to patentability in accordance with 37 C.F.R. § 1.56.

27. On information and belief, Plaintiff knowingly withheld material information from the United States Patent & Trademark Office during the prosecution of the '986 Patent, in violation of 37 C.F.R. § 1.56. Specifically, Plaintiff and/or Plaintiff's counsel was aware of the material, non-cumulative teachings and information contained in German Patent No. 3,840,440 as Plaintiff's counsel, Merchant & Gould, P.C., did and/or does represent the patentee for the German Patent in various patent matters. Plaintiff and/or Plaintiff's counsel failed to disclose the aforementioned German Patent to the United States Patent and Trademark Office during prosecution of the '986 Patent.

**COUNTERCLAIM XI**  
**INEQUITABLE CONDUCT - UNENFORCEABILITY OF THE '986 PATENT**

28. The '986 Patent is unenforceable against Defendants due to Plaintiff's inequitable conduct during prosecution of that patent.

29. Plaintiff and each individual associated with the filing and prosecution of the patent application that matured into the '986 Patent had a duty to disclose to the United States Patent and Trademark Office all information known to be material to patentability in accordance with 37 C.F.R. § 1.56.

30. Plaintiff and each individual associated with the filing and prosecution of the patent application that matured into the '986 Patent had a duty to disclose the existence of prior

or pending litigation involving the subject matter of the '986 Patent in accordance with 37 C.F.R. § 1.56 and M.P.E.P. § 2001.06(c).

31. In the case of *Ecolab, Inc. v. Gilbert Industries, Inc.*, Civil Action No. 3-94-1505 in the United States District Court for the District of Minnesota, Plaintiff claimed, at least in part, that Gilbert Industries, Inc. infringed the '690 Patent.

32. In the case of *Ecolab, Inc. v. Paraclipse, Inc.*, Civil Action No. 94-601 in the United States District Court for the District of Nebraska, Plaintiff claimed, at least in part, that Paraclipse, Inc. infringed the '690 Patent.

33. In the case of *Ecolab, Inc. v. Paraclipse, Inc.*, Civil Action No. 97-304 in the United States District Court for the District of Nebraska, Plaintiff claimed, at least in part, that Paraclipse, Inc. infringed the '690 Patent and the '017 Patent.

34. In the case of *Ecolab, Inc. v. Gardner Manufacturing Co.*, Civil Action No. 00-2294 in the United States District Court for the District of Minnesota, Plaintiff claimed, at least in part, that Gardner Manufacturing Co. infringed the '690 Patent and the '017 Patent.

35. The '986 Patent claims priority to the '690 Patent.

36. On information and belief, Plaintiff knowingly withheld material information from the United States Patent & Trademark Office during the prosecution of the '986 Patent, in violation of 37 C.F.R. § 1.56 and M.P.E.P. § 2001.06(c). Specifically, Plaintiff and/or Plaintiff's counsel was aware of the litigation referenced above in Paragraphs 31 through 34 and failed to disclose the existence of such litigation, and/or any other material information arising therefrom, to the United States Patent and Trademark Office during prosecution of the '986 Patent.

#### **JURY DEMAND**

Pursuant to Fed.R.Civ.P. 38(a), Defendants request a trial by jury.

**PRAYER FOR RELIEF**

WHEREFORE, Defendants respectfully request that this Court:

- (a) Enter judgment dismissing Plaintiff's Amended Complaint with prejudice and on the merits;
- (b) Enter judgment sustaining Defendants' defenses and affirmative defenses;
- (c) Enter judgment declaring that Defendants have neither directly infringed, willfully infringed, induced infringement, nor contributorily infringed any valid claim of the '690 Patent, the '017 Patent and the '986 Patent;
- (d) Enter judgment declaring that the '690 Patent, the '017 Patent and the '986 Patent are invalid;
- (e) Enter judgment declaring that the '690 Patent, the '017 Patent and the '986 Patent are unenforceable due to Plaintiff's inequitable conduct;
- (f) Grant Defendants their costs in addition to their attorneys' fees, in accordance with 35 U.S.C. § 285, and otherwise according to law; and
- (g) Grant Defendants such other relief as the Court may deem just and equitable.

Respectfully submitted,

**PATTERSON, THUENTE, SKAAR &  
CHRISTENSEN, P.A.**

Dated: February 14, 2005

By: s/Matthew T. Macari  
Randall T. Skaar (#165,013)  
Matthew T. Macari (#308,717)  
Aaron W. Davis (#318,255)  
4800 IDS Center  
80 South Eighth Street  
Minneapolis, MN 55402  
Telephone: 612-349-5740

**ATTORNEYS FOR DEFENDANTS  
PESTWEST ELECTRONICS, LTD AND  
PESTWEST USA, LLC**

**UNITED STATES DISTRICT COURT  
DISTRICT OF MINNESOTA**

---

ECOLAB, INC.,  
a Delaware corporation,

Court File No. 04-3049 JMR/FLN

Plaintiff,

vs.

PESTWEST ELECTRONICS, LTD.,  
and PESTWEST USA, LLC,

Defendants.

---

**ORDER OF DISMISSAL**

On consideration of the parties' Stipulated Motion to Dismiss Action Based on Final Settlement, which is herein incorporated by reference, it is hereby ORDERED that the motion is granted and this action, and all of its respective claims, is dismissed with prejudice.

DATED this 18 day of April 2005.

s/James M. Rosenbaum  
The Honorable James Rosenbaum  
Chief Judge, United States District Court  
District of Minnesota